UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

AS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/473,300	12/28/99	HONBO	H 503.34465VC3

020457
IM52/0420
ANTONELLI TERRY STOUT AND KRAUS
SUITE 1800
1300 NORTH SEVENTEENTH STREET
ARLINGTON VA 22209

EXAMINER	
HENDRICKSON, S	
ART UNIT	**PAPER NUMBER**
1754	13

DATE MAILED: 04/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/473,300	Applicant(s) HONBO ET AL.	
	Examiner Stuart Hendrickson	Art Unit 1754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 February 2001* .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-39* is/are pending in the application.

4a) Of the above claim(s) *5,6,10-22 and 24-27* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4, 7-9, 23 and 28-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claims *1-39* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

15)☒ Notice of References Cited (PTO-892)

16)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 .

18)☐ Interview Summary (PTO-413) Paper No(s). _____ .

19)☐ Notice of Informal Patent Application (PTO-152)

20)☐ Other: .

The previous restriction is updated to include claims 28 and 29 with (elected) Group I and claims 30-39 being generic. Claims 30-39 will be examined to the extent they read upon the elected subject matter. The nonelected subject matter (e.g. acid solution of claim 30, 23b, etc.) should be removed from these claims. Similarly, claims 7 and 8 should not depend from claim 5.

Applicant's election with traverse of Group I in Paper No. 12 is acknowledged. The traversal is on the ground(s) that the claims are generic. This is not found persuasive because indeed, the claims are generic and encompass a plurality of materially different processes, and for the reasons previously made. The graphite has alternate utility as a lubricant.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 7-9, 28 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) In claim 1 line 5, 'for obtaining' should be 'and recovering'. Generally, 'for' clauses should be avoided and replaced with phrases which actually limit the claims. See also claims 2, 3 etc.

B) In claim 1 line 8, 'the' crystalline structure is, strictly speaking, without antecedent basis.

C) Claim 4 is unclear in that the phraseology of claim 1 already requires the sequence recited in claim 4. Clarification is requested.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 7-9, 23 and 28-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1087046.

Longstaff teaches on pg. 2 graphite having some particles of the claimed size (which results from grinding) being moderately heated, then heated to 2700 degrees C. The claims do not exclude ('comprising') the additional steps and materials of the reference, nor do the 'for' clauses actually limit the claims. It is noted that the recovery of a 70 micron fraction meets the claimed 'for obtaining' language- in so far as this language actually constitutes a limitation.

Longstaff does not explicitly screen the graphite, however the reporting of the size breakdowns implies that grinding and screening have been done. In any event, grinding and screening graphite to a narrow size distribution is an obvious expedient to provide graphite of the size ('more than 50 microns') desired by Longstaff.

The examiner takes Official Notice that the specific techniques claimed (ie, claim 7) are old and known in the art. Using them is an obvious expedient to attain the results desired by the reference. Moreover, the properties of the graphite (claim 8) appear to be conventional values.

Claims 1, 2, 4, 7-9, 23, 28 and 30-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukagoshi et al. taken with Bennett et al.

Tsukagoshi teaches in column 4 obtaining 100 micron graphite, heating to 1000 degrees then to 2500 degrees. Tsukagoshi does not recite how the initial material is obtained, however Bennett teaches in column 2 milling and screening graphite. Using this technique in the process of Tsukagoshi is an obvious expedient to obtain the desired particle size graphite. As above, the specifics appear to be old and known, and/or properties of graphite.

4013760 is of interest.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (703) 308-2539.

Stuart Hendrickson
Primary examiner AU 1754